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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,554	11/21/2003	Michael Rubin	4727-C2-03-DCL	3555

7590 03/01/2006  
Warner-Lambert Company LLC  
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EXAMINER

KWON, BRIAN YONG S

ART UNIT PAPER NUMBER

1614

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,554

Applicant(s)

RUBIN ET AL.

Examiner

Brian S. Kwon

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/19/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for the benefit of a prior-filed applications (US 10/082,477, filed February 22, 2002, which is continuation of US 09/761,026, filed January 16, 2001) under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buch et al. (US 5723106) in view of Clark, Jr. et al. (US 4933172).

Claims read on an oral composition comprising at least one non-steroidal anti-inflammatory agent (NSAID), thymol, methyl salicylate, menthol, a sugar alcohol (i.e., sorbitol) and a surfactant (i.e., poloxamer).

Buch teaches an oral care composition comprising about 0.07 to about 0.11% w/v of eucalyptol; about 0.02 to about 0.06% w/v of menthol; about 0.03 to about 0.08% w/v of methyl salicylate; about 0.03 to about 0.09% w/v of thymol; about 0.1 to about 0.3% w/v of benzoic acid; a sugar alcohol (i.e., sorbitol) and a surfactant (i.e., poloxamer). See from column 2, line 21 thru column 5, line 16. Furthermore, the reference teaches the use of said composition for preventing and reducing gingivitis.

Clark teaches the use of an NSAID (about 0.09 to about 15% w/v) for preventing and treating gingivitis.

The teaching of Buch differs from the claimed invention in the addition of nonsteroidal anti-inflammatory drug (i.e., NSAID) in said composition to prepare the claimed composition comprising NSAID, thymol, methyl salicylate, menthol, eucalyptol, benzoic acid, a sugar alcohol (i.e., sorbitol) and a surfactant (i.e., poloxamer) for treating or preventing gingivitis. To incorporate such teaching into the teaching of Buch, would have been obvious in view of Clark, Jr. who teaches the use of NSAID for treating gingivitis.

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The use of thymol, methyl salicylate, menthol, eucalyptol benzoic acid, a sugar alcohol (i.e., sorbitol) and a surfactant (i.e., poloxamer) in an oral composition (i.e., Listerine) for treating gingivitis are well known in the art (Listermint Mouthwash USPTO Reg. T.M. No. 1 808 737 Registered Dec. 7, 1993 first used in commerce Oct. 31, 1988; Cool Mint Listerine Antiseptic Mouthwash USPTO Reg. T.M. No. 1 728 521 Registered Oct. 27, 1992 first used in commerce; Listermint Mouthwash and Gargle USPTO Reg. T.M. No. 956 233 Registered Mar. 27, 1973 first use in commerce Jan. 7, 1972). Furthermore, the incorporation of anti-inflammatory agents in an oral composition for treating gingivitis in combination with essential oils including effective amounts of thymol, methyl salicylate, menthol and eucalyptol are well known in the art (US 6132702; US 5942211; and US 5817295). Thus, the invention corresponding to the present claims can be invented with ease by a person having ordinary skill in the art to which the subject matter of the invention pertains prior to the application of this case based on the old and well known knowledge prior to the application date of this case.

Above references in combination make clear that NSID and the composition comprising thymol, methyl salicylate, menthol, eucalyptol benzoic acid, a sugar alcohol (i.e., sorbitol) and a surfactant (i.e., poloxamer) have been individually used for the treatment of gingivitis. It is obvious to combine two compositions each of which is taught by prior art to be useful for same purpose; idea of combining them flows logically from their having been individually taught in the prior art. The combination of active ingredient with the same character is merely the additive effect of each individual component. *See In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).*

With respect to claim 2, the modified composition of Buch includes all that is recited in claim 2 except “synergistically effective amounts”. However, the mere statement of

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“synergistically effective amounts” in the claim without showing unexpected results over the prior art is considered an obvious task for the skilled artisan. Since the claimed range of each ingredients overlaps with the prior art range, the combining all the ingredients which is taught by prior to be useful for the same purpose would have arrived at the claimed invention, absence evidence to the contrary.

Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 1-9 are properly rejected under 35 USC 103.

### ***Conclusion***

3. No Claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Brian Kwon  
Patent Examiner  
AU 1614

